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03-31-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SPORTS MACHINE, INC.  
d/b/a Bike Source,

Opposer

v.

MIDWEST MERCHANDISING, INC.

Applicant

Opposition No.: 122,948

Application No.: 76/035,008

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**OPPOSER'S ANSWER TO APPLICANT'S MOTION TO RESUME PROCEEDINGS  
AND ENTER JUDGMENT UNDER TBMP 510.02(b)**

Opposer, Sports Machine, Inc., by its attorney, hereby agrees with the motion to dissolve the suspension of the subject proceedings (the "Opposition"), but vigorously opposes Applicant's motion to have judgment entered in favor of Applicant.

A memorandum brief responding to Applicant's motion, as required by 37 C.F.R. 2.127(a), is attached.

Respectfully submitted:

Date: 3/26/03

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**MEMORANDUM BRIEF RESPONDING TO APPLICANT'S MOTION TO RESUME  
PROCEEDINGS AND ENTER JUDGMENT UNDER TBMP 510.02(b)**

Opposer has no objection to Applicant's motion to dissolve the suspension of the opposition proceedings and resume proceedings herein. As noted, in the Board's decision suspending the proceedings, the next step is resetting appropriate dates. Opposer requests the TTAB do so.

However, Opposer vigorously opposes Applicant's motion to enter judgment in Applicant's favor in light of the disposition of Cancellation No. 30,578.

Opposer in the present proceeding was Petitioner in Cancellation No. 30,578, which involved Applicant's registered mark, BIKESOURCE (in stylized form). Previously, Opposer had moved to consolidate the cancellation proceeding and the present opposition proceeding (see Exhibit A, Opposer's Motion to Consolidate Proceedings). The motion was presented so that Board could consider consolidation, and because the proceeding shared "common issues of law and fact." However, the Board denied the motion to

consolidate the proceedings.

Opposer would direct the Board's attention to this misstatement contained in Applicant's brief:

"The Board so ruled in its decision of November 14, 2001, agreeing with Opposer<sup>1</sup> that the 'co-pending Cancellation and Opposition do involve nearly identical legal and factual issues and thus have a bearing on one another."

Opposer never made such a statement. Indeed, as the Board correctly pointed out, such a statement was contained in Applicant's brief in opposition to Opposer's motion to suspend the opposition proceeding pending the Board's decision on the motion to consolidate (see Exhibit B, p. 3).

In any event, in its previous ruling in this proceeding, the Board indicated that "[w]ithin twenty days after the final determination [of the cancellation proceeding], the interested party should call up this case for appropriate action. If and when proceedings herein are resumed, appropriate dates will be reset."

Applicant's motion for entry in its favor is premature because the Board's decision in the cancellation proceeding is not dispositive of this opposition proceeding. If the Board had granted the petition to cancel the BIKESOURCE (in stylized form) mark, its decision likely would have been dispositive of the opposition proceeding, and the BIKESOURCE word mark would logically have been refused registration. However, the Board's refusal to cancel BIKESOURCE (in stylized form) mark does not necessarily mean the BIKESOURCE word mark is entitled to registration on the Principal Register.

The Board's decision in the cancellation proceeding referred only to the mark BIKESOURCE in stylized form, and therefore is not res judicata on the issue of

descriptiveness of the term BIKESOURCE. The Board considered the mark "in its entirety" in denying the petition to cancel the mark. Apparently, Registrant felt the stylization was important to the mark's commercial impression, since the mark had been filed with a special form drawing.

However, Applicant's present application to register the mark BIKESOURCE (no stylization) requires that the word create "a distinct commercial impression apart from any stylization in presentation." TMEP §807.09(a). Opposer would show in this proceeding that, unlike the stylized mark, the word mark is not registerable. In its decision in the cancellation proceeding, the Board noted that:

"it is clear that 'bike' is a shortened term for 'bicycle' and 'source' is a broad term relating to the place from which something comes . . ."

In previous court decisions, it has been held that the mere combination of two terms to form a mark does not automatically elevate a descriptive mark to the status of a suggestive mark. Computerland Corp. v. Microland Computer Corp., 224 USPQ 866, 868-869 (N.D. Calif. 1984). A combination of merely descriptive terms may be registerable only if the juxtaposition of words is inventive, or evokes a unique commercial impression, or if the resulting combination has incongruous meaning as applied to the goods or services. In re Colonial Stores Inc., 157 USPQ 382 (CCPA 1968). There is nothing particularly distinctive about the use of either "Bike" or "Source" for retail sales of bicycles, and the words retain their descriptive, even generic, significance when joined to form a compound word. The average purchaser of bicycles, when viewing a retail store sign "BIKESOURCE" would immediately recognize it as a retail outlet for bicycles. Such a purchaser would not be

likely to believe the mark means anything other than a retail store for bikes. A prospective purchaser seeing an advertisement for BIKESOURCE would, similarly, understand that he could go to the outlet and purchase a bicycle. The word mark BIKESOURCE contains no fanciful or arbitrary elements. Even taken as a whole, the mark is not suggestive. No double entendre is suggested and no imagination or thought is required for a consumer to conclude the nature of the services provided: the mark "literally communicates the . . . services offered" by Midwest Merchandising. Computerland Corp. v. Microland Computer Corp., *supra*, 224 USPQ at 868 rejecting "Computerland" for retail computer stores, calling the mark descriptive, although perilously close to generic; see also Abercrombie & Fitch Co. v. Hunting World, Inc., 189 USPQ 759, 764-766 (2d Cir. 1976) holding "Safariland" unprotectable as generic when applied to a store selling safari clothes.

As the Board knows, not every service mark is entitled to registration on the Principal Register, yet the mark can still function as a service mark. Opposer is not seeking registration of the term BIKE SOURCE for its retail services. Opposer is simply trying to prevent Applicant from acquiring prima facie ownership of the words bike and source, in connection with retail bicycle services. Opposer should be able to use Bike Source (descriptive or possibly generic words) rather than simply Bike Store, Bike Outlet, or Bike Dealer (all generic terms) in connection with its retail bicycle services. For that reason, Opposer is entitled to pursue its opposition to registration of Applicant's word mark BIKESOURCE.

WHEREFORE, Opposer requests the Board to resume the present opposition proceeding and to deny Applicant's motion for judgment in favor of Applicant.

Respectfully Submitted,

SPORTS MACHINE, INC., d/b/a Bike Source,  
by its attorney

*Mary J. Gaskin*

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Fax: (281)363-4066

Date: March 26, 2003

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CERTIFICATE UNDER 37 CFR 1.8

The undersigned hereby certifies that this motion is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB - NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on March 26, 2003.

By: *Mary J. Gaskin*  
Mary J. Gaskin

CERTIFICATE OF SERVICE

I hereby certify that the foregoing OPPOSER'S ANSWER TO APPLICANT'S MOTION TO RESUME PROCEEDINGS AND ENTER JUDGMENT UNDER TBMP 510.02(b) was served on counsel for Applicant, this 26<sup>th</sup> day of March, 2003, by mailing a true copy thereof via First Class U.S. Mail, postage prepaid, addressed to Roger A. Gilcrest, Standley & Gilcrest, L.L.P., Attorney for Registrant, 495 Metro Place South, Suite 210, Dublin, Ohio 43017-5319.

  
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Mary J. Gaskin

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Opposer

v.

MIDWEST MERCHANDISING, INC.,

Applicant

Opposition No. 122,948

Serial No. 76/035,008

Mark: BIKESOURCE

**OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS**

Opposer, Sports Machine, Inc., pursuant to TBMP §1214, herein moves the Board for an Order consolidating the proceedings in the above-captioned Opposition Action with the proceedings in Cancellation No. 30,578, Registration No. 1,887,592 (Mark: BIKESOURCE, Special Form).

In the Notice of Opposition previously filed, Opposer asked to have the opposition proceeding consolidated with Cancellation No. 30,578, for a determination of Applicant's/Registrant's rights to the service mark in both the special and the word form.

In Paper No. 2, received from the TTAB in response to the Notice of Opposition, the Legal Assistant indicated that, if the parties to this proceeding are also parties to other TTAB proceedings involving related marks, they should notify the TTAB so that the TTAB

**EXHIBIT A**



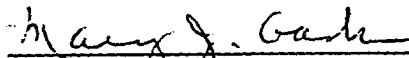
can consider consolidation of both proceedings.

The parties to both the opposition proceeding and the cancellation proceeding are identical. In addition, the pending cancellation proceeding related to the BIKESOURCE (Special Form) mark shares common issues of law and fact with the present opposition proceeding related to the BIKESOURCE mark.

WHEREFORE, Opposer requests that the TTAB order this proceeding be consolidated with Cancellation No. 30,578, for a determination of Applicant's/Registrant's rights to the service mark in special and/or word form.

Respectfully Submitted,

SPORTS MACHINE, INC., d/b/a Bike Source,  
by its attorney



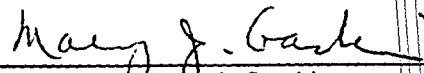
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Phone: (281)363-9121  
Fax: (281)363-4066

Date: July 5, 2001

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CERTIFICATE UNDER 37 CFR 1.8

The undersigned hereby certifies that this motion is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB - NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on July 5, 2001.

By:   
Mary J. Gaskin

motconbk.trd

CERTIFICATE OF SERVICE

I hereby certify that the foregoing OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS was served on counsel for Applicant, this 5<sup>th</sup> day of July, 2001, by mailing a true copy thereof via First Class U.S. Mail, postage prepaid, addressed to Roger A. Gilcrest, Standley & Gilcrest, L.L.P., Attorney for Registrant, 495 Metro Place South, Suite 210, Dublin, Ohio 43017-5319.

Mary J. Gaskin

Mary J. Gaskin